

## **REMARKS**

### **Overview**

Claims 1, 4-25, and 27-29 are pending in the present application. The present action has withdrawn the prior rejections to the claims but has introduced new grounds of rejection to all claims except claim 28, which remains allowable. The present response is an earnest effort to move the application towards allowance. The new grounds of rejection have been carefully reviewed. Reconsideration and passage to issuance is therefore respectfully requested based on the following remarks.

### **Allowed Claim 28**

Applicant gratefully acknowledges the continued finding of allowability of claim 28.

### **35 U.S.C. § 103 Rejections**

The sole rejection of the remaining claims is obviousness. U.S. Patent No. 6,040,512 to inventor Polley ("Polley") is the primary reference. Newly cited U.S. Published Application No. 2002/0178891 to inventor Atkin ("Atkin") is the secondary reference. U.S. Patent No. 4,993,302 ("Jonathan") is cited in some of the rejections as a secondary reference as is U.S. Published Application No. 2002/0108483 ("Smith"). Polley, Jonathan, and Smith were previously of record and have been previously discussed in Applicant's prior responses. Those remarks are incorporated by reference herein.

The Atkin newly cited publication has been carefully reviewed. It is first pointed out that the whole focus of Atkin is related to how one would attach a pick to a sleeve mounted on the thumb of a user. The preferred embodiment of Atkin literally shows VELCRO™ piece 43 glued

to a side of pick 38, and a complimentary VELCRO™ piece 41 glued or sewn to a thumb sleeve 32, such that the pick can be removably attached to the thumb sleeve 32 by the complimentary hook and loop pieces (e.g. VELCRO™ pieces). This expressly teaches away from the Applicant's invention, which is how to improve grippability of the pick without changing the essential characteristics of the pick. The requirement of adding the thumb sleeve and the means to attach the pick to the thumb sleeve is quite a modification to the pick. Thus, again, Polley teaches away from Applicant's claimed invention.

Polley also has a VELCRO™ piece glued to a pick. The teaching of Polley is that this alone provides improved grippability of the pick.

Jonathan has soft pieces that are glued to opposite sides of the pick and then has additional adhesive applied on the outside of the soft pieces to improve grippability.

Smith has textured material which is glued around the back end of the pick.

Thus, in all cases, a piece is glued or attached by adhesive to the pick. Applicant's claims go in a different direction.

Note the following explicit limitations in Applicant's claim 1 which differ from the cited art:

- A thin piece of material. It is not a combination of pieces or pieces and substances: like Atkin's complimentary VELCRO™ pieces, thumb sleeve, and adhesives, like Polley's VELCRO™ piece, backing and adhesive, like Jonathon's multiple pieces and adhesives, or like Smith's piece and adhesive.
- Removable. It does not have any part or piece glued to the pick, like Atkin, Polley, Jonathan, and Smith.

However, to further clarify these differences between Applicant's claims and the cited art, the independent claims have been amended. Particularly note, the claims have been clarified to emphasize that Applicant's apparatus is:

- Removable and repeatedly reusable on a guitar pick. The piece is removable and replaceable on either the same pick or different picks. It is not a one-time application like the pieces of Atkin, Polley, Jonathan, and Smith that are glued on. It is thus also reusable. It can be used indefinitely even if picks wear out, are thrown away, or are lost.
- Inherent properties. The piece functions by the inherent properties of the material it is made of. This is in direct contrast to Atkin, which requires glue, a separate substance, to attach a VELCRO™ piece to the pick, the VELCRO™ on the pick is to allow removable attachment of the pick to thumb sleeve 32, not to help the user's finger grip the pick. This is contrast to Polley, Jonathan, and Smith which require glue, a separate substance, to attach pieces to the pick.
- No residue. The piece does not leave a substantial residue or remnant on fingers or pick, even when first placed and then removed from the pick. This is in contrast to Atkin, which glues the VELCRO™ piece to the pick. If the VELCRO™ piece can even be removed, it would leave residue of the adhesive. The same is true of Polley, Jonathan, and Smith. They do not teach, suggest, or contemplate removable of the piece glued to the pick.
- Does not require a separate adhesive or mounting structure. As pointed out, each of the cited references teach use of adhesive to glue a piece to the pick. And Atkin teaches further away by requiring a separate piece, thumb sleeve 32, with

complimentary VELCRO™ piece, to allow attachment of the pick to the sleeve—  
not to allow grippability of the pick by the user's fingers.

Support for these amendments is found throughout Applicant's specification. Indeed, the Background of the Invention through the claims and drawings sets forth the idea of an apparatus that (a) can be used and reused on different picks, (b) can be applied, removed, and reapplied to the same pick or another pick, (c) does not change the essential characteristics of the pick, and (d) improves grip of the pick by a user's fingers. As pointed out above, none of the cited references teach, suggest, or provide any motivation for this combination.

Polley intentionally teaches gluing of one piece of a hook and loop fastening material to the pick to improve grippability or so you can hang the pick on a complimentary piece of hook and loop material fixed to the guitar body.

Smith wraps and glues textured material around the back of the pick.

Jonathan permanently glues soft pieces of rubber on opposite sides of the pick and then adds and lets harden an adhesive to the outside of the soft rubber for improved grippability.

Atkin glues one piece of hook and loop fastening material to the pick (like Polley) and has a complimentary piece of hook and loop fastener mounted on the sleeve or band that goes around a guitar player's finger. This allows the pick to be attached to the guitar player's finger.

Therefore, no cited reference teaches the combination of limitations in Applicant's independent claims. Each teaches use of glue to attach a piece to the pick. Furthermore, Atkin teaches away not only from Applicant's claims, but from Polley because it teaches two complimentary pieces of VELCRO™, one glued to the pick, another glued or sewn to a thumb

sleeve, all for the purpose of attaching the pick to a thumb sleeve---not to help a user's fingers grip a surface of the pick.

As recently stated by the Federal Circuit, a *prima facie* case of obviousness requires there be not only a teaching that the cited references should be combined, but a teaching, suggestion or motivation to combine them in a manner that meets the limitations of Applicant's claims. Even if these cited references are combined, none of them suggests Applicant's claims. Indeed, they teach away.

Therefore, Applicant respectfully requests reconsideration based on this response. Applicant respectfully submits the independent claims are not obvious based in light of the cited references and that the dependent claims are allowable for the reasons expressed in support of the independent claims.

There are very real and significant reasons why Applicant's claimed invention has functional advantages over the cited references. For example, the cited references are not truly reusable or moveable from one pick to the other. Moreover, Polley does change the basic characteristics of the pick. Polley specifically recognizes the dangers of changing the pick characteristics. At column 3, lines 9-12, Polley specifically warns against gluing VELCRO™ pieces to both sides of the pick:

"However, providing the hook closure material 47 on both sides is not preferred, because provides a thick, unfamiliar feel which is undesirable to many musicians."

To glue even one piece of VELCRO™ on one side involves adding a piece that is at least as thick as the pick.

Furthermore, many musicians want to change between picks, even during the same song. One pick is stored in the player's palm while the other is gripped with the player's fingers. The

sleeve and VELCRO™ piece of Atkin would make switching picks cumbersome. Also, attaching the pick by VELCRO™ to the sleeve does not allow for easy changing of the pick position in the fingers. Sometimes the player wants to grip it at its upper end (e.g., for soft strumming) and sometimes nearer its tip (e.g., it will play "stiffer"). One pick may produce a different sound that is desired for one part of the song, and another pick a different sound that is desired for another part of the song. Atkin would make this difficult. The Adkin-type pick with VELCRO™ piece would be attachable to the VELCRO™ piece on the thumb sleeve if the musician wanted to use that pick, but the thumb sleeve and VELCRO™ piece would be cumbersome and disruptive if the musician wanted to switch to a non-Adkin-type pick. The thumb sleeve and the VELCRO™ piece would not promote grip of the standard pick. Furthermore, the musician would not want to stop playing to remove the thumb sleeve. Atkin teaches away from the Applicant's claimed invention.

Applicant's claim 1 has a combination of limitations that is not taught, as a whole, by the cited references, either individually or in combination. In fact, the cited references teach away from Applicant's claim 1. Applicant's other independent claims rejected as obvious have similar limitations to those of claim 1. Therefore, Applicant's independent claims 1, 17, 22, 25, and 29 are submitted to be non-obvious and patentable over the cited references.

The remaining claims rejected as obvious are dependent from one of the independent claims and are submitted to be allowable for the reasons expressed in support of the independent claims.

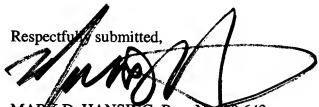
## Conclusion

It is respectfully submitted all matters raised in the Office Action have been addressed and remedied and the Application is in form for allowance. Favorable action is respectfully requested.

It is not believed that any fees or request for extensions of time are required for entry of this response. However, if any such fees or requests are required, please consider this a request therefore and charge any required fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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